



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/881,872

06/14/2001

Bhupesh Gupta

AUS920010383US1

8222

35525

7590

11/22/2006

IBM CORP (YA)

C/O YEE & ASSOCIATES PC

P.O. BOX 802333

DALLAS, TX 75380

EXAMINER

REFAI, RAMSEY

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED
NOV 22 2006
Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/881,872
Filing Date: June 14, 2001
Appellant(s): GUPTA, BHUPESH

Gerald H. Glanzman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2006 appealing from the Office action mailed March 3, 2006.

Art Unit: 2152

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board' s decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant' s statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant' s statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

This Examiner' s Answer contains new grounds of rejection, presented in the (9) Grounds of Rejection section below.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Art Unit: 2152

6,965,920	Pedersen	07-2001
6,101,320	Schuetze et al	08-1997
6,438,584	Powers	03-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 rejected under 35 U.S.C. 103(a) as being unpatentable by Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920).

3. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

identifying a recipient of an electronic mail message (column 3, lines 3 - 5); and

formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 - 22).

4. Gilbert fails to teach retrieving one or more recipient profiles from storage wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.

Art Unit: 2152

5. However, Pedersen teaches an individual message generator that obtains information from recipient profiles stored in a database and generates individual messages for each recipient based on that information (abstract, column 2, lines 26-67, column 3, lines 48-65). It would have been obvious to one of the ordinary skill in the art at the time of the Appellant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a method for customizing electronic mail messages by referring to stored recipient profiles to ensure that all messages addressed to that particular recipient are customized according to that stored recipient profile.

6. As per claim 4, Gilbert teaches an electronic mail message directed to a plurality of designated recipients, and wherein formatting the electronic mail message includes identifying a set of compatible electronic mail format settings from among the content of electronic mail format settings of the designated recipients (column 4, lines 16-30).

7. As per claim 5, Gilbert teaches if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (column 7, lines 47-48).

8. As per claim 6, Gilbert teaches electronic mail format settings include at least one of closing information, stationery, or whether to use spell check (column 6, lines 38-67, Figure 3, column 4, lines 64-66; user can select specific text in message to reformat. Also teaches spell checking).

Art Unit: 2152

9. As per claim 7, Gilbert teaches electronic mail message is directed to a plurality of designated recipients (column 3, lines 13-16), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format is specific to the electronic mail format of a corresponding recipient profile (column 1, lines 54-61, column 3, lines 11-16, and column 4, lines 16-30).

10. As per claim 8, Gilbert teaches an electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (column 1, lines 58-61).

11. As per claim 9, Gilbert teaches an electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them (column 1, lines 39-42; teaches that a user must view multiple versions of a message).

12. As per claims 11, 16-19, 21-22, 25-30, 32, and 35-40, these claims fail to add any further limitations and contain the same limitations as claims 1-9 above, therefore are rejected under the same rationale.

13. Claims 2-3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920) and in further view of Schuetze et al (U.S. Patent No. 6,101,320).

Art Unit: 2152

14. As per claim 2, Gilbert fails to teach that one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.

15. However, Schuetze et al teach a routing unit that determines the identity of the recipient' s organization and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient' s organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the Appellant' s invention to combine the teachings of Gilbert, Pedersen and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient' s of another organization can view and understand.

16. As per claim 3, Gilbert fails to teach one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.

17. However, Schuetze et al teach a routing unit that determines the identity of the recipient' s organization using the domain name of the organization (column 5, lines 1-3) and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient' s organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the Appellant' s invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because

Art Unit: 2152

doing so would allow an email sender from a different organization to send an email in a format that the recipient' s of another organization can view and understand.

18. As per claim 10, Gilbert teaches an electronic mail message is directed to more than one designated recipient (column 3, lines 13-16).

19. Gilbert fails to teach an electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, and an individual set of electronic mail format settings for each of the at least one designated recipient; comparing each set of electronic mail format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail message.

20. However, Schuetze et al teach electronic mail message includes identifying a common set of electronic mail content format settings for the more than one designated recipient (column 4, line 61 - column 5, line 3), and wherein identifying a common set of electronic mail content format settings includes: identifying at least one of a group set of electronic mail format settings (column 5, lines 43-46), a domain name category set of electronic mail content format settings (column 5, lines 1-3), and an individual set of electronic mail format settings for each of the at least one designated recipient (column 4, line 61 - column 5, line 3); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one

Art Unit: 2152

designated recipient to identify matching sets of electronic mail content format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail content message (column 9, line 66-column 10, line 15; shows that users in an organization would be grouped as one organization; therefore messages sent to recipients of the same organization would be sent in a message of the format of the recipients' organization). It would have been obvious to one of the ordinary skill in the art at the time of the Appellant's invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

21. As per claims 12-15, 20, 23-24, 31, 33-34, and 41, these claims fail to add any further limitations and contain the same limitations as claims 2-3 and 10 above, therefore are rejected under the same rationale.

NEW GROUNDS OF REJECTION:

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Appellant for a patent.

23. Claims 1-5, 7-8, 10-15, 17-18, 20-26, 28-29, 31-36, 38-39, and 41 are rejected under 35 U.S.C. 102(a) as being anticipated by Schuetze et al (U.S. Patent No. 6,101,320).

Art Unit: 2152

24. As per claim 1, Schuetze et al a method of formatting an electronic mail message, comprising:

retrieving one or more recipient profiles from storage, wherein each recipient profile in the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient (column 6, lines 1-16; system searches through memory unit for format to be used for intended recipient);

identifying a recipient of an electronic mail message (column 6, lines 3-4; the electronic mail identifies the recipient); and

formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (column 6, lines 7-16, column 5, lines 28-39; the electronic mail is reformatted into the format of the intended recipient).

25. As per claim 2, Schuetze et al wherein the one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients (abstract, column 4, line 61-column 5, line 3, column 8, lines 29-67; common format for all users in a recipient organization).

26. As per claim 3, Schuetze et al wherein the one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients (column 4, line 61-column 5, line 3; domain name identifies recipient organization).

Art Unit: 2152

27. As per claim 4, Schuetze et al wherein the electronic mail message is directed to a plurality of designated recipients (column 4, line 51-55; can communicate electronic mail to any number of organizations), and wherein formatting content of the electronic mail message includes identifying a set of compatible electronic mail format settings from among the electronic mail format settings of the designated recipients (column 5, lines 7-39).

28. As per claim 5, Schuetze et al wherein if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (column 7, lines 2-14; if no information regarding the electronic format of a recipient can found, the message is sent using the standard format).

29. As per claim 7, Schuetze et al wherein the electronic mail message is directed to a plurality of designated recipients (column 4, line 51-55; can communicate electronic mail to any number of organizations), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail format of a corresponding recipient profile (column 2, lines 8-10, column 4, line 56-column 5, lines 28, column 6, lines 1-16; different versions of the message received at each organization in the corresponding format).

30. As per claim 8, Schuetze et al wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (column 4, line

Art Unit: 2152

50-column 5, lines 39, column 2, lines 7-10; different versions of the message received at each organization specified by the sender in the corresponding format).

31. As per claim 10, Schuetze et al wherein the electronic mail message is directed to more than one designated recipient (column 4, line 51-55; can communicate electronic mail to any number of organizations), and wherein formatting the electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, or an individual set of electronic mail format settings for each of the at least one designated recipient (column 4, line 61-column 5, line 3, column 6, lines 1-16); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and using the machine sets of electronic mail content format settings to reformat content of the electronic mail message (column 6, lines 1-16; the electronic mail is reformatted into the format of the intended recipient identified in the electronic mail).

32. As per claims 11-15, 17-18, 20-26, 28-29, 31-36, 38, 39, and 41, these claims contain similar limitations as claims 1-5, 7-8, and 10 above, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2152

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claim 9, 19, 30, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuetze et al (U.S. Patent No. 6,101,320).

35. As per claims 9, 19, 30, and 40, Schuetze et al fail to teach wherein the user may review the versions of the electronic mail message prior to transmitting them. However, it would have been obvious to one of ordinary skill in the art to include the feature of reviewing the versions of the electronic mail message prior to transmitting them to ensure that each version of the message has been reformatted correctly. This ensures that each version of the message has not been altered due to the reformatting of the message into the respective recipient's format.

36. Claims 6, 16, 27, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuetze et al (U.S. Patent No. 6,101,320) and Powers (U.S. Patent No. 6,438,584).

37. As per claims 6, 16, 27, and 37, Schuetze et al fail to teach wherein the electronic mail format settings include at least one of closing information, stationery, or whether to use spell check. However, Powers teaches a database that contains recipient preferences, which are specified by a sender. These recipient preferences include closing information and stationery. (See column 6, lines 13-18, 45-50, and 55-60) It would have been obvious to one of ordinary skill in the art at the time of the Appellant's invention to combine the teachings of Schuetze et al and Powers because doing so would create a method of personalizing an electronic message by reformatting the electronic message based on recipient preferences stored in recipient profiles.

Art Unit: 2152

(10) Response to Argument

In the ARGUMENT section, the Appellant argues in substance:

- Argument A: *Gilbert does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.*

In response, the Examiner asserts that Gilbert was not relied upon to teach this feature. The Pedersen reference was used to cure the deficiencies of Gilbert, more specifically, to teach the above limitation. (Point to Pedersen citation).

- Argument B: *Pedersen does not teach the feature missing from Gilbert including formatting content of the electronic message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.*

In response, the Examiner respectfully disagrees. Pedersen teaches a system and method for management of how messages are distributed to recipients. Recipient profiles are entered and stored regarding rules for recipient message preferences. The individual message generator of the message management system communicates with the database to identify message parameters in recipient profiles to generate individualized messages. Therefore Pedersen meets the scope of the claimed limitation. (See Abstract, column 3, lines 47-52, column 6, lines 62-67)

- Argument C: *Pedersen does not teach that a recipient profile contains settings for content of the electronic message.*

In response, the Examiner respectfully disagrees. Pedersen teaches that a recipient will specify profile parameters, such as type of messages, type of content the recipient wishes to receive, how messages must be distributed, where to receive the specified message and the type of message devices to transmit the messages. Therefore, Pedersen meets the scope of the claimed limitation. (See column 7, line 55-column 8, line 5, fig. 2).

Art Unit: 2152

- Argument D: *Pedersen does not teach a recipient profile that contains electronic mail message format settings that correspond to the formatting of the content.*

In response, the Examiner respectfully disagrees. Pedersen teaches that a recipient will specify profile parameters, such as type of messages, type of content the recipient wishes to receive, how messages must be distributed, where to receive the specified message and the type of message devices to transmit the messages. (See column 7, line 55–column 8, line 5, fig. 2).

Pedersen further teaches the message management system manages the delivery format of messages. (See column 3, lines 60–63, column 1, lines 25–30) Therefore, Pedersen meets the scope of the claimed limitation.

- Argument E: *No motivation to combine Gilbert and Pedersen.*

38. In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gilbert teaches a method, which allows the originating user to customize text for specific recipients. This method can be implemented either on the originating user's computer, the recipient's computer, or *on a computer coupled to the network such as a mail server.* (column 6, lines 1–4, column 7, lines 35–39). Gilbert further teaches that the method determines if an identifier code has been assigned to a recipient by *matching the recipients' user name with the embedded processing codes to find a match.* (column 7, lines 45–55).

Pedersen teaches a system and method for management of how messages are distributed to recipients. Recipient profiles are entered and stored regarding rules for recipient message

Art Unit: 2152

preferences in a database located in a message management server (fig 2). The individual message generator of the message management system communicates with the database to identify message parameters in recipient profiles to generate individualized messages. (abstract, column 3, lines 47-52, column 6, lines 62-67). It would have been obvious to one of the ordinary skill in the art at the time of the Appellant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a method for customizing electronic mail messages by referring to stored recipient profiles to ensure that all messages addressed to that particular recipient are customized according to that stored recipient profile.

- Argument F: *Gilbert does not teach or suggest electronic format settings that include closing information, stationery, or spell check.*

In response, the Examiner respectfully disagrees. Gilbert teaches that text of an email message can be formatted for features such as size, color, and style. (column 4, line 54-column 5, line 5) Once the email message has been generated, the software determines the text to be formatted as selected by the originating user. (column 6, line 39-column 7, line 7) Then a sensitive menu allows the user to select from a group of displayed functions, such as spell check. (column 6, lines 50-56). The claim language does not require all three features claimed (closing information, stationery, or spell check), but merely requires one of the three. Furthermore, the claim merely states that spell check is an electronic format settings and does not mention how, where, or when the spell checking is done. Therefore Gilbert meets the scope of the claimed limitation.

- Argument G: *Schuetze does not teach formatting the content of the electronic message but is concerned with the transmission format.*

In response, the Examiner respectfully disagrees. Schuetze clearly teaches that the system and method determines the electronic mail format used by the recipients by searching for

Art Unit: 2152

information regarding the recipient and then converts the electronic message into the recipient' s format. (abstract, column 3, lines 17-35). Reformatting the electronic message into the recipient' s format inherently *reformats the content* of the message. Therefore Schuetze meets the scope of the claimed limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner' s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner' s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within TWO MONTHS from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

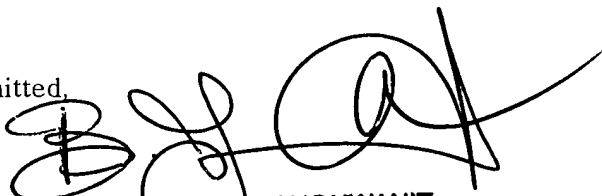
(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Art Unit: 2152

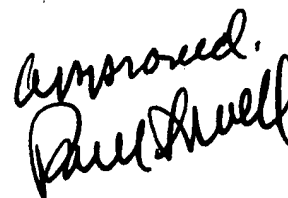
Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

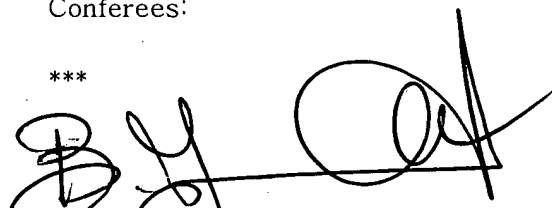
Ramsey Refai


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:




Conferees:



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

PAUL SEWELL
ACTING DIRECTOR


ARIE ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 2100